

## REMARKS

Claims 1-12 and 15-35 are pending in the application. Claims 4-8 and 23-26 are withdrawn from consideration by the Examiner. Claims 1-3, 9-12, 15-22 and 27-35 are rejected in this Office Action. Claim 34 is objected to.

### Claim Objection

The Examiner objected to claim 34 because gallant is spelled incorrectly. Applicant has amended claim 34 with the correct spelling, "gellant".

### Rejections Under 35 U.S.C. §112 second paragraph and 35 U.S.C. §101

The Examiner rejected claim 20 under 35 U.S.C. §112 second paragraph and 35 U.S.C. §101. The Examiner indicated that the claim does not set forth any steps in the method/process.

Applicants have deleted claim 20.

### Rejections Under 35 U.S.C. §103 (a)

The Examiner rejected claims 1-3, 9-12, 15, 17-18, 20-21, and 31-33 under 35 U.S.C. §103(a) as being unpatentable over Loginova et al. (US Patent 6,524,565) ("the '565 patent").

The Examiner rejected claims 1-3, 9-12, 15, 17-18, 20-21, and 31-33 under 35 U.S.C. §103(a) as being unpatentable over Loginova et al. (US Patent 6,524,565) ("the '565 patent") in view of Patel et al (US Patent 6,342,209) ("the '209 patent").

First applicants would like to bring to the Examiner's attention that the standard for rejection under 35 U.S.C. §103(a) is obviousness not unpatentable. Applicants will respond accordingly.

A proper obviousness analysis requires that the Examiner must establish a *prima facie* case of unpatentability based on obviousness. In doing so the Examiner should

evaluate the totality of the facts and all the evidence to determine whether the claimed invention would have been obvious. MPEP § 2144.08 (II).

Currently, to establish a *prima facie* case, the PTO must satisfy three requirements:

- 1) **the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references.** See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding"); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); *Abbott Laboratories v. Syntrol Bioresearch, Inc.*, 334 F.3d 1343, 67 U.S.P.Q.2d 1337 (Fed. Cir.), *reh'g denied*, 2003 U.S. App. LEXIS 17605 (2003) ("Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim obvious. The issue is whether substantial evidence supports the judgment (under the clear and convincing evidence standard) that a person having ordinary skill in the art would not have been motivated to replace the [prior art process] with [the process of the invention].");
- 2) **the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.** In

other words, a hindsight analysis is not allowed. See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991) (While the idea of using a monkey gene to probe for a homologous human gene may have been "obvious to try," many pitfalls existed that would have eliminated a reasonable expectation of successfully obtaining the EPO gene. "Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious."); and

- 3) **the prior art reference or combination of references must teach or suggest all the limitations of the claims.** See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

In determining obviousness, §103 expressly requires considering the claimed invention "as a whole." Focusing the §103 inquiry on a particular aspect of the invention that differs from the prior art improperly disregards the "as a whole" statutory mandate. See *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1383, 231 U.S.P.Q. at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, as the district court did in frequently describing the claimed invention as the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay, was a legally improper way to simplify the difficult determination of obviousness."); *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 U.S.P.Q. 1021, 1026 (Fed. Cir. 1984) (treating an unclaimed advantage as the gist of the patented invention "disregards the statutory requirement that the invention be viewed 'as a whole,' ignores the problem-recognition element, and injects an improper 'obvious to try' consideration"); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. ... This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention."); *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed.Cir. 2005):

The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. ... Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. ... This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result--often the essence of invention. [internal citations to *Ruiz* omitted].

In this Office Action the Examiner has focused on the obviousness of substitutions instead of on the invention as a whole. It is well established in the cases presented above that this is an improper way to simplify the difficult determination of obviousness.

Applicants invention requires:

1. a first film forming siloxane polymer;
2. a second film forming silicone acrylic copolymer; and
3. a nonpolar oil.

The '565 patent discloses only use of a single water-emulsifiable film forming agent and a single oil soluble polymeric film-former in a cosmetic composition. The Examiner admits that the '565 patent fails to disclose the second film-forming polymer to be a silicone acrylic copolymer.

The Examiner turns to the '209 patent for the disclosure of a silicone acrylic copolymer. In doing so the Examiner has not considered the invention as a whole.

In column 1, lines 56-62 of the '209 patent, a plasticizer in combination with the film-forming polymers is required to achieve an acceptable cosmetic product.

"A plasticizer is a most important ingredient in cosmetic and personal care products containing polymeric film formers."

In the current application the applicants go against the teaching of the '209 patent by removing the required plasticizer while still obtaining an acceptable cosmetic product.

Applicants have achieved an unexpected result and therefore can not be held as obvious over the '209 patent that teaches this result could not be obtained.

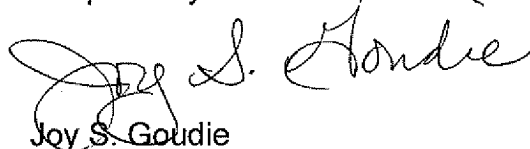
The prior art reference or combination of references must teach or suggest all the limitations of the claims. The '209 and '565 patents fail to teach or suggest all the limitations of the claims as discussed above.

For the reasons above the Examiner has failed to establish a *prima facie* case of obviousness and is respectfully requested to reconsider the rejection under 35 U.S.C. §103(a).

In view of the above amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance and earnestly request such action.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Joy S. Goudie".

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